

## REMARKS

Reconsideration of this application is respectfully requested.

Claims **1, 2 and 6** were rejected under 35 U.S.C. 102(b) as being anticipated by Buck et al. (US 2,022,756). Claims **1-3, 5-7, 10** and **11** were rejected under 35 U.S.C. 103(a) as being unpatentable over Mosman (U.S. 4,977,684) in view of Betz (U.S. 3,087,251) and Buck (U.S. 2,022,756). Finally, claims **4, 8 and 9** were rejected under 35 U.S.C. 103(a) as being unpatentable over Mosman (U.S. 4,977,684) in view of Betz (U.S. 3,087,251) and Buck (U.S. 2,022,756) and further in view of Valentine, Sr. (U.S. 5,815,940).

Applicants have amended claims **1** and **8** to more distinctly claim those features of their invention which are unique and novel over the prior art. Specifically, applicants have amended claims **1** and **8** to include the previous restrictions of claims **3** and **4** and further has added that the forward tongue is generally free of projecting objects, as follows:

an extendable generally flat planar rear tail having an outer end and an inner end and a fixed length as measured between said outer end and said inner end, said rear tail movably mounted on said tape housing generally opposite said tape outlet opening, said rear tail operative to project outwards from said tape housing;

a generally flat planar forward tongue having inner and outer ends, said inner end of said forward tongue hingedly mounted on said outer end of said measuring tape with said forward tongue extending forwards therefrom, said forward tongue being pivotable between a retracted position in general parallel alignment with and contacting said measuring tape and an extended position extending outwards generally parallel with said measuring tape, said outer end of said forward tongue being generally free of projecting objects mounted thereon whereby said outer end of said forward tongue is operative to be extended into narrow openings:

Applicants have made these changes to further point out the critical distinctions between the cited prior art and applicants' invention, and therefore applicants respectfully disagree with the examiner's stated arguments. The combination of four prior art elements as cited by the examiner clearly points to the use by the examiner of applicants' claimed invention as a template for assembling the grounds for rejection. Applicants would like to state that the modifications of the prior art necessary to function as does applicants' invention are not found anywhere in the cited prior art, but instead are only found in Applicants' disclosure, particularly in light of the currently amended claims. As the Federal Circuit stated in *In re Fitch*; "The mere fact that the prior art may be modified

1 to reflect features of claimed invention does not make modification, and hence the claimed  
2 invention, obvious unless the desirability of such modification is suggested by the prior art. It is  
3 impermissible to use the claimed invention as an instruction manual or "template" to piece together  
4 the teachings of the prior art so that the claimed invention is rendered obvious. This court has  
5 previously stated that 'One cannot use hindsight reconstruction to pick and choose among isolated  
6 disclosures in the prior art to deprecate the claimed invention.'" In re Fitch, 23 USPQ2d 1780, 1783-  
7 4, *citing from In re Gordon*, 733 F.2d at 902, 221 USPQ at 1127 and In re Fine, 837 F.2d at 1075,  
8 5 USPQ2d at 1600. Clearly, any suggestion to combine the elements found in the prior art is only  
9 found in the applicant's specification. Therefore it is seen that not only is applicants' invention not  
10 disclosed in the prior art, but applicants' invention is not even fairly suggested by the prior art.

11 The cited base patent, Mosman, teaches the use of an extendable tail on a tape measure for  
12 measuring inside measurements. As argued by the examiner, it would have been obvious to modify  
13 Mosman to include inside and outside measurements as taught by Buck and further to include a  
14 tongue as taught in Betz and Valentine. However, modification of Mosman in this manner will not  
15 replicate applicants' invention. Why not? Because the use of a tongue as taught by Betz includes  
16 a downwardly projecting clip section which would prevent the extension of the tongue into narrow  
17 spaces as is desired with applicants invention. Furthermore, as shown in Mosman Figures 6-9, the  
18 downwardly projecting clip section is an integral part of the Mosman device and removal of it would  
19 be contrary to the teachings of Mosman. In fact, the only suggestion to modify Mosman as suggested  
20 by the examiner is found in applicants' disclosure, and nowhere else in the cited prior art. It can  
21 fairly be said that the cited prior art does not disclose nor suggest the use of a projecting object free  
22 tongue as currently claimed by applicants, and modification of Mosman to include such a tongue will  
23 cause Mosman to not function as intended by its inventor. As was stated by the C.C.P.A. in In re  
24 Rosen; "The modification necessary to the primary reference in order to achieve the patented design  
25 may not destroy fundamental characteristics of the primary reference." In re Rosen, 673 F.2d 388,  
26 391, 213 USPQ 347, 350 (C.C.P.A. 1982). For all of these reasons, it is believed that the rejections  
27 of claims 1 and 8 have been overcome.

28 Claims 2, 5, 6, 7 and 9 were rejected along with claims 1 and 8, but applicants wish to clarify

1 that they do not claim exclusive rights to the features defined in those claims independently, but  
2 rather only in combination with the present invention as defined in claims **1** and **8**. For the reasons  
3 expressed above in connection with claims **1** and **8** and for the structural limitations added by these  
4 claims, claims **2, 5, 6, 7** and **9** are believed to be allowable with claims **1** and **8**. Claims **3, 4, 10** and  
5 **11** have been canceled.

6 Applicant is mailing this amendment after expiration of the three month response period but  
7 within the first month's extension of time permitted by 37 C.F.R. § 1.136 and accompanied by the  
8 fee set forth in 37 C.F.R. § 1.17(a). This application is thus believed to be in condition for allowance  
9 of all claims remaining herein, and such action is respectfully requested.

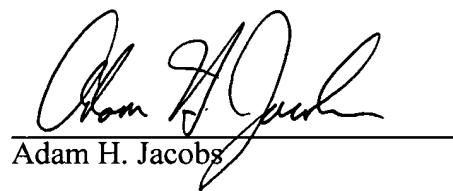
10 Respectfully submitted,



11  
12  
13 Adam H. Jacobs  
14 Registration № 37,852  
15 Law Offices of Adam H. Jacobs  
16 1904 Farnam Street, Suite 726  
17 Omaha, Nebraska 68102  
18 Attorney for Petitioner

19 CERTIFICATE OF MAILING

20 I hereby certify that this Amendment for a DUAL OPTION TAPE MEASURE, Serial №  
21 10/700,943, was mailed by first class mail, postage prepaid, to Mail Stop Non-Fee Amendment,  
22 Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 29th day of October,  
23 2004.



---

24 Adam H. Jacobs  
25  
26  
27  
28